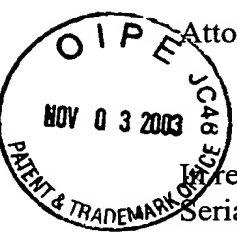


1646



Attorney's Docket No. 9151-6

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Wheeler et al.

Group Art Unit: 1646

Serial No.: 09/823,069

Confirmation No.: 8239

Filed: March 30, 2001

Examiner: Basi

For: METHODS AND COMPOSITIONS UTILIZING AN ALTERNATIVE SPLICE  
VARIANT OF THE SIGMA-1 RECEPTOR

Date: October 31, 2003

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RECEIVED

NOV 06 2003

RESPONSE TO RESTRICTION REQUIREMENT TECH CENTER 1600/2900

Sir:

In response to the Restriction Requirement dated October 2, 2003, set forth therein, Applicants hereby elect Group II, Claims 1-7 and 11 "drawn to isolated polynucleotide encoding the polypeptide of SEQ ID NO: 2, expression vector comprising said polynucleotide, cell comprising said vector and method of preparing said polypeptide using a cell containing said vector classified in class 536, subclass 23.1", with traverse, for substantive examination.

Applicants respectfully request reconsideration of the restriction requirement as to Groups I, III, IV, VI, IX, and XI. It is respectfully submitted that a search of these claims would overlap with a search of Group II, hence grouping these claims together would not present an undue burden to the Patent Office.

Applicants also traverse this restriction on the basis that the Examiner has not demonstrated that the requirements for claim restriction have been met. In particular, it is stated in section 803 of the MPEP that two criteria for proper restriction of claims must be met: 1) The inventions must be independent and distinct as claimed, AND 2) there must be a serious burden on the examiner if restriction is required. The MPEP further states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."

In particular, the examiner has not met the second criterion because there is no evidence provided that it would be a serious burden to examine the claims together. The MPEP states that "[f]or purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate

status in the art, or a different field of search as defined in MPEP 808.02."

Applicants believe that the Examiner has not met the requirements of a *prima facie* showing of why search and examination of all of the claims together would pose a serious burden. In particular, the claims of groups II and VI are all classified in class 536 and subclass 23.1 and thus the Examiner would not need to search more than a single subclass for all of these claims. Thus, applicants respectfully request that this restriction be reconsidered and withdrawn.

Furthermore, if the claims of Group II are found to be allowable, Applicants request that the Examiner review the claims of Groups IX and XI according to the practice of rejoinder as set forth in section 821.04 of the MPEP. In particular, it is stated therein that if a product claim is elected in a restriction and then found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim are to be rejoined

The Examiner is encouraged to contact the undersigned directly if such contact will expedite the examination and allowance of the pending claims.

No fee is believed due with this response. However, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-0220.

It is respectfully submitted that this application is in condition for substantive examination, which action is respectfully requested.

Respectfully submitted,



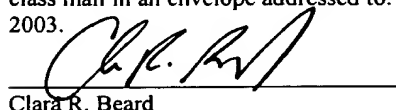
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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on October 31, 2003.

  
Clara R. Beard